

## REMARKS

### Summary of the Office Action

Claims 17-22 are objected to due to informalities.

Claims 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0063453 to Kusagaya et al. in view of U.S. Patent No. 6,693,793 to Kuwako et al.

Claims 20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kusagaya et al. and Kuwako et al., as applied to claim 17 above, and further in view of U.S. Patent No. 5,155,072 to Bruno et al.

Claim 21 has been indicated as containing allowable subject matter.

### Summary of the Response to the Office Action

Applicants have amended independent claim 17 to improve its form and further clarify the invention. Accordingly, claims 17-22 remain pending in this application for further consideration with claims 1-16 and 23-25 being withdrawn from consideration.

### Objection to Claims 17-22

Claims 17-22 are objected to because of lack of the antecedent basis in independent claim 17. Applicants have amended claim 17 by replacing “the cured capacitor” with “the cured capacitor paste” in accordance with the Examiner’s comments set forth in Section 1 of the Office

Action. Accordingly, Applicants respectfully assert that the objection to claim 17 and to its dependent claims 18-22 be withdrawn.

**Rejections under 35 U.S.C. § 103(a)**

Claims 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kusagaya et al. in view of Kuwako et al., and claims 20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Kusagaya et al. and Kuwako et al., as applied to claim 17 above, and further in view of Bruno et al. To the extent that the rejections might be reapplied to the claims as presently amended, they are respectfully traversed as being based on references that, whether taken individually or in combination, do not teach or suggest the novel combination of features recited in the claims.

With respect to independent claim 17, Applicants respectfully submit that Kusagaya et al. and Kuwako et al., whether taken individually or in combination, do not teach or suggest the claimed combination including at least a recited feature of “a polymer capacitor paste having high-dielectric constant,” and a recited feature of “a power layer copper foil ... including a dry film pattern that is laminated on the power layer copper foil and is etched by use of an etching mask to partition the power layer copper foil.”

The Office Action at page 3 concedes that Kusagaya et al. “is silent about the dielectric constant of the polymer film.” However, the Office Action insists that “[i]t is known (scientifically) in the art that the capacity (capacitance) of the condenser will depend upon the dielectric constant of the polymer (insulation) between the conductive layers (power and ground layers).” Then, the Office Action goes on to allege that “it has been held that discovering an

optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).” Applicants respectfully disagree.

Although the Office Action on Page 7 provides further explanation, as well as a prior art of Sisler (U.S. Patent No. 5,010,641), of why it is very well known in the art that the capacity (capacitance) of the condenser will depend upon the dielectric constant, Applicants respectfully submit that none of the applied references teaches or suggests “a polymer capacitor paste having **high**-dielectric constant,” (Emphasis Added), as recited by newly-amended independent claim 17. Since all of the applied references, whether taken individually or in combination, fail to teach or suggest that the dielectric constant of a polymer capacitor paste is **high**, Applicants respectfully submit that those applied references are limited merely to the disclosure in “Description of the Prior Art” of the specification

Further, the Office Action appears to allege that a third layer L3 of Kusagaya et al. reads on the claimed “power layer copper foil.” In contrast to the present invention of newly-amended independent claim 17, Kusagaya et al. merely discloses that the third layer L3 is formed as an electric power source layer, but fails to teach or suggest that the third layer L 3 is “a power layer copper foil ... including a dry film pattern that is laminated on the power layer copper foil,” as recited by newly-amended independent claim 17.

Furthermore, In contrast to the present invention of newly-amended independent claim 17, Kusagaya et al. also fails to teach or suggest that the third layer L 3 is “a power layer copper foil ... including a dry film pattern that ... is etched by use of an etching mask to **partition the power layer copper foil**,” as recited by newly-amended independent claim 17 (Emphasis Added).

In addition, the Office Action does not rely on Kuwako et al. and Bruno et al. to remedy any aspect of the above-noted deficiencies of Kusagaya et al. Also, Applicants respectfully submit that Kuwako et al. and Bruno et al. cannot remedy the deficiencies of Kusagaya et al. That is, all of the applied references, whether taken individually or in combination, do not teach or suggest the claimed combination including at least the above-described features recited in newly-amended independent claim 17.

MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 U SPQ 580 (CCPA 1974)."

Accordingly, for at least the forgoing reasons, Applicants respectfully assert that the rejection of independent claim 17 under 35 U.S.C. § 103(a) should be withdrawn. Furthermore, Applicants respectfully assert that dependent claims 18-22 are allowable at least because of their dependencies from independent claim 17 and the reasons set forth above.

With no other rejections pending, Applicants respectfully assert that claims 17-22 are in condition for allowance.

### **Conclusion**

In view of the foregoing, Applicants respectfully request the reconsideration and the timely allowance of the pending claims. Should the Examiner believe that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS, LLP**

By: 

Xiaobin You  
Reg. No. L0112

Dated: May 12, 2006

**CUSTOMER NO. 009629**  
**MORGAN, LEWIS & BOCKIUS, LLP**  
1111 Pennsylvania Avenue, NW  
Washington, DC 20004  
Tel 202.739.3000  
Fax 202.739.3001